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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,707	04/10/2001	James U. Morrison	26017-3	1778

7590

08/07/2003

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EXAMINER

WHITE, EVERETT NMN

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 08/07/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,707

Applicant(s)

MORRISON, JAMES U.

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-27 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The amendment filed July 15, 2003 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
 - (A) Claims 1-14 and 28-42 have been canceled;
 - (B) Claims 15 and 18-20 have been amended.
 - (C) Comments regarding the Art Rejections have been provided drawn to:
 - (a) 102(b) and (e) rejection, which has been maintained for the reasons of record;
 - (b) 103(a) rejection, which has been withdrawn.
2. Claims 15-27 and 43 are pending in the case.
3. The text of those sections of title 35, U. S. Code not included in this action can be found in a prior Office action.

Final Office Action Withdrawn

4. The finality of the Office Action mailed March 7, 2003 has been withdrawn for the reasons disclosed below.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 43 is rejected under 35 U.S.C. 102(a) as being anticipated by Rosner (US Patent No. 6,387,361, already of record).

Applicants claim a method of treating a patient to stimulate weight loss comprising administering an acarbose formulation to the patient, wherein such formulation does not include a lipase inhibitor.

The Rosner patent discloses a method of controlling weight in a human comprising administering to the human acarbose at meals with food containing carbohydrate, which anticipates the method of instant Claim 43.

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6. Applicant's arguments with respect to Claim 43 have been considered but are moot in view of the new ground(s) of rejection.

7. Claims 15-27 stand rejected under 35 U.S.C. 102(e) as being anticipated by Patel et al (US Patent No. 6,309,663, already of record) for the reasons already of record in the previously filed Office Actions.

8. Applicant's arguments filed July 15, 2003 have been fully considered but they are not persuasive. Applicants amended the claims by changing the term "comprising" to -- consisting essentially of --. Applicants argue that the instant claims as amended exclude additional components of the Patel's composition that include at least two surfactants. Applicants argue that their composition, namely "the rate, extent and/or consistency of bioabsorption" of the composition would be unexpectedly enhanced in the presence of "at least two surfactants". This argument is not persuasive since the presence of two surfactants would not necessarily enhance "the rate, extent and/or consistency of bioabsorption" of a composition. Applicants argue that the Patel patent does not disclose a sustained release matrix. This argument is not persuasive since the Patel patent at column 39, line 31, clearly use the term "sustained release" to described a component of their composition, which anticipates the "sustained release matrix" of the instant claims. In response to applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which applicant relies (i.e., location of the release of the agent, pH-independence, the acarbose and sustained release matrix being dry mixed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Accordingly, the rejection of Claims 15-27 under 35 U.S.C. 102(e) as being anticipated by the Patel et al patent is maintained for the reasons of record.

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9. Claims 15-27 stand rejected under 35 U.S.C. 102(b) as being anticipated by Bremer et al (US Patent No. 5,643,874, already of record) for the reasons already of record in the previously filed Office Actions.

10. Applicant's arguments filed July 15, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection of Claims 15-27 over the Bremer et al patent on the grounds that the claims as amended (changing "comprising" to "consisting essentially of") excludes the presence of other ingredients that would change the novel and basic characteristics of the claimed composition. If Applicants are referring to the novel and basic characteristics of the claimed composition as the acarbose and sustained release matrix, then this argument is not persuasive since there is no indication in the Bremer et al patent that the presence of the lipase inhibitor in the composition of the Bremer et al patent alters the chemical formula of the acarbose and the hydroxypropylmethylcellulose of the Bremer et al patent. See instant Claim 24 wherein the sustained release matrix is hydroxypropylmethylcellulose. Applicants argue that the hydroxypropylmethylcellulose of the Bremer et al patent only causes release and increase residence time in the stomach. This argument is not persuasive. Applicants are reminded that products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada 15 USPQ 2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. It is further noted that the Bremer et al patent indicates that the composition thereof is used in the treatment of obesity, which further supports anticipation of the Bremer et al patent over the instant claims since the instant specification teaches the use of the instantly claimed composition to stimulate weight loss. Accordingly, the rejection of Claims 15-27 under 35 U.S.C. 102(b) as being anticipated by the Bremer et al patent is maintained for the reasons of record.

Summary

11. All the pending claims are rejected.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Examiner's Telephone Number, Fax Number, and Other Information

For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

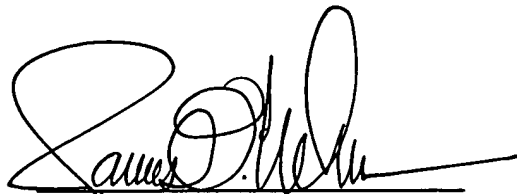
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (703) 308-4624. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



E. White


James O. Wilson
Supervisory Primary Examiner
Technology Center 1600